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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/047,717 03/25/98 TANIGUCHI M U-011678-8

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EXAMINER

SHOSHQ,C

ART UNIT

PAPER NUMBER

1714

10

DATE MAILED:

01/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/047,717

Applicant(s)

Taniguchi et al.

Examiner

Calle Shosho

Group Art Unit

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☒ Responsive to communication(s) filed on Oct 25, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-11 and 13-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 and 13-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by the applicants' amendment filed on 10/25/99.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 as presently amended depends on claim 12 which was canceled by the amendment filed 10/25/99. Should 12 be changed to 22?

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. It is noted that although claim 12 was canceled, new claim 22 incorporates limitations identical to those in the canceled claim with the only difference being that the claim is now written in independent form, so that the rejections as set forth in the office action mailed 4/23/99 are equally applicable to claim 22 as they were to claim 12. Further, note that the Nagasawa et al. is discontinued in light of applicant's arguments.

6. Claims 1-11 and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoffel et al. (U.S. 5,555,008) in view of Tomita et al. (U.S. 5,019,164), Breton et al. (U.S. 5,833,744), Schwarz, Jr. (U.S. 5,223,026), Marritt (U.S. 5,871,572), Sano et al. (U.S. 5,769,930), Yamashita et al. (U.S. 5,370,731), Yui et al. (U.S. 5,622,549), and Shimomura et al. (U.S. 5,866,638).

The rejection is adequately set forth in paragraph 5 of the office action mailed 4/23/99, Paper No.7, and is incorporated here by reference.

7. Claims 1-11 and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita et al. (U.S. 5,019,164) in view of Stoffel et al. (U.S. 5,555,008), Breton et al. (U.S. 5,833,744), Schwarz, Jr. (U.S. 5,223,026), Marritt (U.S. 5,871,572), Sano et al. (U.S. 5,769,930), Yamashita et al. (U.S. 5,370,731), Yui et al. (U.S. 5,622,549), and Shimomura et al. (U.S. 5,866,638).

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The rejection is adequately set forth in paragraph 6 of the office action mailed 4/23/99, Paper No.7, and is incorporated here by reference.

8. Claims 1-11 and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al. (U.S. 5,624,484) in view of Tomita et al. (U.S. 5,019,164), Schwarz, Jr. (U.S. 5,223,026), Marritt (U.S. 5,871,572), Sano et al. (U.S. 5,769,930), Yamashita et al. (U.S. 5,370,731), Yui et al. (U.S. 5,622,549), and Shimomura et al. (U.S. 5,866,638).

The rejection is adequately set forth in paragraph 7 of the office action mailed 4/23/99, Paper No.7, and is incorporated here by reference.

Response to arguments regarding 35 USC 103 rejections

9. Applicants' arguments with respect to the Nagasawa et al. reference have been considered and are moot in view of the discontinuation of this reference as applied against the present claims.

10. Applicant's arguments filed 10/25/99 have been fully considered but, with the exception of arguments relating to the Nagasawa et al. reference, they are not persuasive.

Specifically, the applicants argue that

(a) although Tomita et al. disclose a cationic resin of the type presently claimed, it is only one of vast number of resins.

(b) The preferred cationic resin of Tomita et al. is polyethyleneimine.

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(c) Comparative data provided in the present specification shows unexpected or surprising results which overcome the Tomita et al. reference.

With respect to argument (a), it is noted that Tomita et al. disclose an ink that contains a mixture of a polyamine containing primary amino groups with a polyamine containing secondary or tertiary amino groups. It is clear that Tomita et al.'s resins, specifically those found in formulas (v) and (vi), are identical to the cationic resin presently claimed when n is 0 or 1. Additionally, given the open language of the present claims, i.e. "cationic, water-soluble resin *comprising* a repeat unit..", as well as the disclosure on page 5, lines 10-26 of the present specification which states that the resin may contain other repeat units including allylamine, it is clear that Tomita et al.'s resins, specifically those found in formulas (ii) and (iii), also encompass the cationic resin presently claimed when n is 0 or 1. Thus, given that Tomita et al. discloses only six types of resins and further that four of the resins are of the type presently claimed, it would have been within the skill level of one of ordinary skill in the art to choose the cationic resin presently claimed without undue experimentation.

Although Tomita et al. discloses a mixture of cationic resins, it is significant to note that the present claims are open to the inclusion of another resin, i.e. "ink *comprising*..", and further present claim 11 as well as the specification, page 5, lines 28-31 explicitly disclose that the ink of the present invention can contain an additional resin. Although the specification additionally discloses that it is preferable that the other resin is nonionic, this is only a preferred embodiment

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and there is no indication, especially in the claims, that the ink of the present invention cannot contain a mixture of two cationic resins.

If applicant were willing to include the limitation of present claim 11 into present claims 1 and 22 along with the limitation that the resin other than the cationic, water-soluble resin is nonionic, the examiner would be willing to reconsider the rejection.

With respect to argument (b), while the examples of Tomita et al. disclose the use of polyethyleneimines only, “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” In re Courtright, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, “nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims.” In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). Although Tomita et al. uses polyethyleneimine in the examples, as discussed with respect to argument (a) above, four of the six cationic resins disclosed by Tomita et al. are of the type utilized in the present invention, and thus it would have been within the skill level of one of ordinary skill in the art to choose the cationic resin presently claimed without undue experimentation.

With respect to argument (c), applicant’s comparative data, summarized in the Table on page 26 of the present specification, compares inks of the present invention containing a cationic

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resin as disclosed in present claim 1 when n is 1 with inks containing either no cation resin, a non-substituted cationic resin, or polyethyleneimine. The data, however, is not persuasive because it is not commensurate in scope with the scope of the present claims given that the present claims disclose that n is either 0, 1, or 2, while the data uses only inks having a cationic resin where n is 1. The courts have held that "comparative data limited to a particular material are insufficient to establish superiority for a broad group of chemical compounds." In re Emiegel, 159 USPQ 716, 404 F.2d 378 (1968). This is especially significant in light of the fact that Tomita et al. discloses cationic resins identical to those presently claimed when n is 0 or 1.

Given that the comparative example 9 does show the criticality of using a cationic resin of the present invention where n is 1 versus using polyethyleneimine (as disclosed by Tomita et al.), should applicant be willing to limit the present claims to cationic resins wherein n is 1, the examiner would be willing to reconsider the rejection.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie Shosho whose telephone number is (703) 305-0208. The examiner can normally be reached on Monday-Thursday from 7:00 am to 4:30 am. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0661.

C. S.

Callie Shosho

12/30/99

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